

REMARKS

Summary of the Office Action

Claims 1, 2 and 4-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,836,224 to *Gerber* (“*Gerber* ‘224”).

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gerber* ‘224 in view of U.S. Patent No. 3,780,607 to *Gerber* (“*Gerber* ‘607”).

Status of the Claims

Applicant proposes canceling claim 6, without prejudice or disclaimer, and amending claim 1. Accordingly, claims 1-5, and 7 are pending for further consideration. Claims 8-22 were withdrawn from consideration.

All Claims Define Allowable Subject Matter

Claims 1, 2 and 4-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Gerber* ‘224. Applicant respectfully traverses the rejection under 35 U.S.C. § 102(b).

Claim 1 recites a sheet processing apparatus for processing sheets on which images have been formed by an image forming apparatus, including a sheet accepting unit, a cutting unit, and a recognizing unit. The sheet accepting unit accepts sheets from the image forming apparatus. The cutting unit cuts the sheets in the form of a sheaf accepted by the sheet accepting unit with a blade that is moved parallel with sheet surfaces. The recognizing unit recognizes information relating to the sheets. The cutting unit determines a movement condition of the blade on the basis of the information relating to the sheets. Support for these features is provided at, for

example, page 13, ll. 15-21; page 14, ll. 10-20; page 33, line 25-page 34, line 4; and Figs. 1 and 12 of Applicant's specification as originally filed.

As mentioned above, the movement condition of the blade is determined on the basis of the information relating to the sheet material S. On the other hand, the movement condition of the cutting blade 28 in *Gerber*'224 is determined by the marker data 18 based on the cutting patterns P, as indicated in the Office Action. The blade movement condition in *Gerber*'224 is not based on the information relating to the sheet material S that is recognized by the reorganizing unit (16, 18, 100). The marker data 18 is a cutting pattern to be cut (see col. 3, lines 25-27) and has no relation to the information relating to the sheet material S. Although the information relating to the sheet material S, including the type of material to be cut and the depth of number of plies of material, is referred to as "cutting conditions" in col. 7, lines 14 and 16-18 of *Gerber*'224, the cutting conditions refer to a series of tests to determine the optimum air pressure for cutting. The optimum air pressures are stored as data in the recognizing unit (16,100). Thus, what is stored is an optimum air pressure and not a movement condition of the blade. See col. 7, lines 14-30 of *Gerber*'224. In *Gerber*'224, the air pressure is used for holding the sheet material S in place on the support surface (col. 2, lines 34-35), the air pressure and the movement of the cutting blade are controlled independently and have no relation to each other.

Applicant also respectfully submits that the Office Action has not established that *Gerber*'224 anticipates each and every feature of Applicant's claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicant contends that newly amended independent claim 1 recites the features of a "recognizing unit [that] recognizes

the number and/or a kind of sheets to be cut in the form of a sheaf.” At least this feature is not disclosed or taught by *Gerber* ‘224.

As described at col. 3, ll. 19-42, and illustrated in Fig. 1, *Gerber* ‘224 is directed to a numerically controlled cutting machine 10 for cutting pattern pieces of a garment (limp sheet material, see Abstract) from a length of sheet material S that is spread over a cutting table 11 and vacuum held in place. The cutting table 11 is a conveyor table. The sheet material S is loaded onto the cutting table 11 from a spreading and loading conveyor 12. The sheet material S is cut in a predetermined pattern. The cut pattern pieces together with the surrounding material are then unloaded from the cutting table by an unloading conveyor 14. The cut pattern pieces P are removed from the unloading conveyor and are transported to a sewing room for assembly into a garment.

However, the disclosure in *Gerber* ‘224 fails to teach or suggest at least the above-mentioned sheaf features of newly amended independent claim 1. That is, the sheet material S (garment) is spread out and cut as a singular sheet and is not first stacked in a sheaf and later cut as in the case for the present invention. Because *Gerber* ‘224 does not disclose the “sheets to be cut in the form of a sheaf” feature, it cannot anticipate the invention recited in newly amended independent claim 1.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Gerber* ‘224 does not teach or suggest each feature of newly amended independent claim 1.

Additionally, Applicant respectfully submits that dependent claims 2-5 and 7 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gerber* '224 in view of *Gerber* '607. Applicant respectfully traverses the rejection for the following reasons.

Applicant respectfully submits that newly amended independent claim 1 includes the features of a “recognizing unit [that] recognizes the number and/or a kind of sheets to be cut in the form of a sheaf.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Gerber* '224 or *Gerber* '607.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

First, none of the cited references teach or suggest “sheets to be cut in the form of a sheaf” as recited in newly amended independent claim 1. The *Gerber* references refer to machinery utilized in the garment industry. Neither reference, therefore, teaches the features in claim 1. Therefore, it is respectfully submitted that the statement in the Office Action is not sufficient by itself to meet the first prong of *prima facie* obviousness. In fact, the MPEP § 2143.01 states that “the level of skill in the art cannot be relied upon to provide the suggestion to

combine references.” *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Second, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation to the references of record that shows the desirability of combining *Gerber* ‘224 and *Gerber* ‘607. Further, as discussed above, the combination of references does not even mention “sheets to be cut in the form of a sheaf” as recited in the present invention. The mere assertion that *Gerber* ‘224 and *Gerber* ‘607 could be combined is not sufficient by itself to establish *prima facie* obviousness. Therefore, it is respectfully submitted that the Office Action has not met the second prong of *prima facie* obviousness.

Third, the Office Action has not established a *prima facie* case of obviousness at least because neither *Gerber* ‘224 nor *Gerber* ‘607, whether alone or in combination, teach or suggest all the recited features of independent claim 1. Namely, neither *Gerber* ‘224 nor *Gerber* ‘607 teach or suggest at least a “recognizing unit [that] recognizes the number and/or a kind of sheets to be cut in the form of a sheaf,” features recited in claim 1. Applicant respectfully submits that *Gerber* ‘607 fails to overcome the above-described deficiencies of *Gerber* ‘224.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met. Therefore, Applicant respectfully

requests that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Gerber* '224 and *Gerber* '607 do not teach or suggest each and every feature of independent claim 1.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

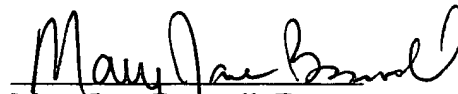
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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